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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/700,839	11/21/2000	Klaus-Dieter Hammer		3537

30678 7590 03/19/2003

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EXAMINER

NOLAN, SANDRA M

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 03/19/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/700,839

Applicant(s)

HAMMER ET AL

Examiner

Sandra M. Nolan

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims

1. Pursuant to entry of the amendments in the correspondence dated 04 December 2002 (Paper No. 10), submitted in response to the office action of 06 August 2002 (Paper No. 5), claims 1-16 are pending.

Rejections Withdrawn

2. The 35 USC 101 rejection of claims 14 and 15, as shown in section 4 of Paper No. 5, is withdrawn in view of the amendments in Paper No. 10.
3. The 35 USC 112 rejection of claim 12 as set out in section 6 of Paper No. 5, is withdrawn in view of the amendments in Paper No. 10.
4. The 35 USC 103 rejection of claims 1, 2, 4, 6, 7, 9, 10, 11, and 13-15 as unpatentable over Bastioli et al (US 5,412,005), as recited in section 9 of Paper No. 5, is withdrawn in view of applicants' arguments in Paper No. 10.

Rejection Maintained

5. The 35 USC 103 rejection of claims 1-15, as unpatentable over Hammer et al (US 5,928,737) in view of DD247830A (abstract), as expressed in section 10 of Paper No. 5, is maintained for reasons of record and is modified to cover claims 1-16.

The particular amounts/combination of ingredients recited in claim 16 is deemed to be the result of optimization of properties, which optimization would be motivated by a desire to improve upon casings suggested by the teachings of the combined references.

Response to Arguments

6. Applicant's arguments filed in Paper No. 10 have been fully considered but they are not persuasive.

The arguments in Paper No. 10 concerning the remaining 35 USC 103 rejection will be responded to in the order in which they were presented.

On page 6, applicants argue that the DD 247830A abstract fails to teach the use of thermoplastic starch with a polyurethane and that the starch used therein is a "native" starch, which acts as a filler.

However, the abstract neither calls for "native starch", nor says that its starch serves as a filler. Instead, the third line of the abstract states, "A PUR-cellulose cpd. is used." Reading "PUR" as polyurethane and "cpd." as compound, it is clear that an interaction takes place between the polyurethane and the cellulose [i.e., starch] since a "compound" is produced. Thus, the DD 247830A starch reacts and is not just a filler.

Also on page 6, applicants argue that the DD 247830A isocyanates would react with its [non-reactive?] starch, so that a polyester urethane could not be obtained.

However, the last three lines of the abstract state that its polyurethanes are made by reacting long chain diols with diisocyanates. Hydroxy-functional polyesters are conventional polyol reactants used when making casings. See page 2, lines 4+ of applicants' specification, where "polyester urethanes" are said to be used in casings.

Final Rejection

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication should be directed to Sandra M. Nolan, whose telephone number is 703/308-9545. The Examiner can normally be reached on Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the Examiner by telephone are unsuccessful, her supervisor, Harold Pyon, can be reached at 703/308-4251. The general fax number for the art unit is 703/305-5436. The fax number for after final communications is 703/872-9310. The receptionist answers 703/308-0661.



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Patent Examiner
Technology Center 1700

SMN/smn
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17 March 2003